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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/697,523	10/30/2003	Helmut L. Kayan	2512 CON2 (203-2719CON2)	7663
7590 Paul R. Audet United States Surgical, a Division of Tyco Healthcare Group LP 150 Glover Avenue Norwalk, CT 06856			EXAMINER LOPEZ, MICHELLE	
			ART UNIT 3721	PAPER NUMBER
			MAIL DATE 09/12/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/697,523	<b>Applicant(s)</b> KAYAN ET AL.	
	<b>Examiner</b> Michelle Lopez	<b>Art Unit</b> 3721	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 October 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 31-48 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 31-38 and 40-48 is/are rejected.
- 7) ☒ Claim(s) 39 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. This action is in response to a telephonic conversation with the applicant's representative on August 28, 2008 and is supplemental to the Non-Final Action mailed June 8, 2008.
2. Claims 1-30 have been canceled in a preliminary amendment filed on 10/30/03. Therefore, the rejection of claims 1-30 as set forth in the Non-Final Action mailed June 8, 2008 is hereby withdrawn.
3. New claims 31-48 have been added in the Preliminary Amendment filed 10/30/03 and considered by the Examiner as set forth in the rejection below.

### ***Specification***

4. The abstract of the disclosure is objected to because it has more than 150 words. Correction is required. See MPEP § 608.01(b).

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**5. Claims 31-33, 35-36, and 41-48 are rejected under 35 U.S.C. 102(b) as being anticipated by MacGarry et al. 5,366,479.** MacGarry discloses a fastening apparatus for use in endoscopic surgery comprising: a handle portion 18; a triggering mechanism 20; a plurality of vertically stacked fasteners 110; a fastener applicator 16 including: a first-half section 16a and a second half section 16b, the first half section includes a flat side (at the vicinity of 124 as shown in fig. 16) having a recessed region formed therein (at the vicinity of 114 as shown in fig. 16) configured to retain the fasteners therein and to slidably receive a pusher via (104R and 104L), the second half section includes a flat side having a recessed portion formed therein as shown in fig. 15, the recessed portion being configured and dimensioned to slidably receive a slide 104; a fastener positioning spring 113; and a stop spring 124. The distal end of the first half section 16a includes a cut away region (see fig. 15) configured to permit ejection on one of the fastener (claim 32). The distal end of the second half section is provided with an anvil via 116,118 (claim 33).

With respect to claim 35-36, 41-44, and 48, MacGarry discloses wherein the anvil is cantilever 116,118 that extends beyond the recessed portion of the second half section and into the cut way region of the first half section as shown in fig. 17. Slot sections formed at the distal end of 16b and ejector springs 124R,124L capable of being housed within said slots. The distal end of the recessed region of the first half section 16a has a ramp as shown in fig. 16. The fastener positioning spring 113 is capable of urge the distal most fastener from the recessed region of the first half section 16a to the recessed region of the second half section as shown in fig. 16, and the stop spring 124 is deemed to retain a fastener adjacent to the distal most fastener

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as shown in fig. 26. The slide 104 is configured to urge the stop spring 124 within recessed region of the second half region 15b as shown in fig. 18.

With respect to claims 46-47, the slide 104 urges the springs 124R,124L into the recessed region of 16b, and wherein when the slide is advanced proximally after having urged the fastener distally to be shaped, the ejector springs 124R,124L urge the shaped fastener off the anvil as shown in fig. 23.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**6. Claims 34, 37-38, 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over MacGarry et al. 5,366,479 in view of Taylor 4,619,262.** MacGarry discloses the claimed fastening apparatus for use in endoscopic surgery having an anvil via 116,118, but fails to disclose wherein said anvil is triangular. Taylor teaches the concept of surgical stapling device having a slide 12 with a notch at the vicinity of 13' being angled to closely match and receive an anvil 20b having an essentially triangular cross-section to properly bend the legs of a fastener as shown in fig. 7. It would have been obvious to one having ordinary skill in the art to have provided McGarry's anvil with a triangular cross-section as taught by Taylor in order to bend the legs of a fastener.

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With respect to claims 37-38, Taylor shows wherein the slide 12 has a distal end shaped to complement the shape of the anvil, and the distal end of the slide includes a notch as shown in figs. 7 and 12.

With respect to claim 40, Taylor fails to disclose wherein the notch of the slide has, as its widest width, a distance essentially equal to a width of the slide. It would have been an obvious matter of design choice to have changed the width of the notch as claimed, since such a modification would have involved a mere change in the shape of a component. A change in shape is generally recognized as being within the level of ordinary skill in the art. The change in shape would be for the benefit of properly matching the shape of the anvil, and it is noted that the disclosure fails to indicate anything critical about said width of the slide.

#### ***Allowable Subject Matter***

7. Claim 39 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See the attached PTO-892 for related art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michelle Lopez whose telephone number is 571-272-4464. The examiner can normally be reached on Monday - Thursday: 8:00 am - 6:00 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada can

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be reached on 571-272-4467. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/ML/

Patent Examiner

/Rinaldi I Rada/

Supervisory Patent Examiner, Art Unit 3721